

REMARKS

The final Office Action dated October 31, 2005, indicated in its summary that claims 16-141 are now pending and claims 112-141 are withdrawn from consideration. Moreover, the final office action indicated in its summary that claims 16-111 are allowed, when in fact, from pages two on of the final office action, the claims are rejected under 35 U.S.C. Section 1103. The indication of allowance in the summary is assumed to be an error. In view of the final office action, Applicant submits an RCE and this preliminary amendment that addresses the rejections made in the final office action. In view of the above amendments and the arguments urged below, reconsideration of this application is respectfully requested.

Also the office action indicated that the information disclosure statement filed on August 26, 2005, fails to fully comply with the 37 CFR 1.98(a)(2). Applicant respectfully submits that an information disclosure statement and forms PTO-1449 are contemporaneously filed with this amendment. With the information disclosure statement, copies of all the foreign patents and articles are also submitted. Consideration of these documents is respectfully submitted. In paragraph 3 of the office action, the Examiner rejected claims 16-42, 45-72, 75-105 and 108-111 under 35 U.S.C. Section 103(a) as being unpatentable over Shavit et al. (U.S. Patent No. 4,799,156) in view of Smith (U.S. Patent No. 5,450,123) and further in view of Filepp et al. (U.S. Patent No. 5,347,632). Moreover, in paragraph 4 of the office action, the Examiner rejected claims 43-44, 73-74, and 106-107 under 35 U.S.C. Section 103(a) as being unpatentable over Shavit, Smith and Filepp, as applied to claims 16, 45, and 77 above, and further in view of Donald et al. (U.S. Patent No. 5,053,956). Specifically, with respect to claims 22-23, 51-52, 84-85, and 110, the Examiner takes "Official Notice" that it is old and well in the art at the time of invention to provide for freeze-frame and high resolution video capability in a video communication system such that it would have been obvious to an artisan or ordinary skill to incorporate such well known video features within the combination of Shavit and Smith.

To that end, Applicant respectfully submits that the Examiner's rejection for obviousness is improper because there is no recitation in the cited prior art references, either singly or in combination, to suggest the desirability of the claimed subject matter. That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the

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"common practice" of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of Applicant's own teachings. The Examiner's attention is directed to the cases set forth below. In addition, for the record, Applicant respectfully traverses the Examiner's reliance on taking Official Notice in rejecting certain claims.

In re Raynes, 7 F.3d 1037, 1039 (Fed. Cir. 1993):

When determining whether a new combination of known elements would have been obvious in terms of 35 U.S.C. § 103, the analytic focus is upon the state of knowledge at the time the invention was made. The Commissioner bears the burden of showing that such knowledge provided some teaching, suggestion, or motivation to make the particular combination that was made by the applicant. *In re Oetiker*, 977 F.2d 1443, 1445-47, 24 U.S.P.Q.2D (BNA) 1443, 1444-46 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. (BNA) 785, 788 (Fed. Cir. 1984). This determination is made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention. 35 U.S.C. § 103; *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991).

In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986):

"There was no suggestion in the prior art to provide Deminski with the motivation to design the valve assembly so that it would be removable as a unit. The board argues that if Pocock had followed the "common practice" of attaching the valve stem to the valve structure, then the valve assembly would be removable as a unit. The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made." 35 U.S.C. § 103 (1982); *In re Spornoble*, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 U.S.P.Q. (BNA) 237, 243 (CCPA 1969)."

The independent claims are amended to further emphasize the distinctions from the asserted art. Applicant respectfully solicits favorable consideration and allowance of the claims based on the amendments and arguments presented here.

Respectfully submitted,

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